

Amdt. dated September 14, 2004

Reply to Office action of August 6, 2004

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-20 remain in the application. None of the claims have been amended.

In reply to the Election/Restriction requirement in the Office Action of August 6, 2004, please note applicants' election of the invention identified as invention I, claims 1-15 drawn to a resin and process for producing the resin. Please also note the election of the second alternative claim 1 species terpene - phenol resin. Claims 2-4 and 8-15 read on the elected species.

The requirement for election and restriction is respectfully traversed. The Examiner is respectfully requested to withdraw the requirement for election and restriction and proceed with examination of claims 1-20 on the merits.

The requirement for restriction and election in this application is respectfully traversed because it is simply unreasonable and inappropriate to require restriction between a base claim and claims dependent thereupon.

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It should be noted that each of claims 16-18, identified as invention II, is in fact a true dependent claim that depends upon claim 1 directly or through an intermediate claim. Each of these claims further limits the scope of the base claim. Each of these claims is drawn to an article of manufacture comprising two substances, i.e., a product of a process claimed in claim 1 or in a process claim dependent upon claim 1, and a polymer identified as chloroprene.

It is therefore not the case that Group I and Group II are "mutually exclusive species." In fact, all species of Group II are included within the embrace of Group I. A search of the art that finds claim 1 to be novel cannot possibly yield art affecting the novelty of any Group II claim.

The same considerations apply to claims 19-20, identified as invention III. Each of claims 19 and 20 is in fact a true dependent claim that depends upon claim 1 directly or through an intermediate claim. Each of these claims further limits the scope of the base claim. Each of these claims is drawn to a process in which a product of a process claimed in claim 1 or in a process claim dependent upon claim 1 is subjected to additional process steps.

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It is therefore not the case that Group I and Group III are "mutually exclusive species." In fact, all species of Group III are included within the embrace of Group I. A search of the art that finds claim 1 to be novel cannot possibly yield art affecting the novelty of any Group III claim.

In this case, it is respectfully submitted, the unjustified expense, effort, and lapse of time in achieving the grant of patent protection that result from the requirement for restriction should not be imposed on the applicant. Withdrawal of the requirement for restriction and prompt examination on the merits of claims 1-20 are believed to be in order, and are respectfully solicited.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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For Applicant's

OSK/tk

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